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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* NICOLE BEAULIEU

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Appeal 2007-4022  
Application 10/073,598  
Technology Center 3700

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Decided: March 10, 2008

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Before MURRIEL E. CRAWFORD, JENNIFER D. BAHR, and  
ANTON W. FETTING, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Nicole Beaulieu (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1-45. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

*The Invention*

Appellant's claimed invention is directed to a casino gaming apparatus and method. Independent claim 12, reproduced below, is illustrative of Appellant's claimed invention.

12. A gaming apparatus, comprising:
  - a display unit that is capable of generating video images;
  - a value input device;
  - a controller operatively coupled to said display unit and said value input device, said controller comprising a processor and a memory operatively coupled to said processor,
    - said controller being programmed to allow a person to make a wager on an occurrence of a wagering game,
    - said controller being programmed to receive data relating to a request from said person made during said occurrence of said wagering game for said controller to make an automated selection from among a plurality of user-selectable options presented to said person,
    - said controller being programmed to make an automated selection from among said a plurality of user-selectable options in response to said request,
    - said controller being programmed to cause a video image to be generated on said display unit, said video image representing a game other than video keno; and

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    said controller being programmed to determine, after said video image has been displayed, a value payout associated with an outcome of said game represented by said video image.

*The Rejections*

The Examiner relies upon the following as evidence of unpatentability:

Walker	US 6,001,016	Dec. 14, 1999
Bennett (Bennett '102)	US 6,093,102	Jul. 25, 2000
Mayeroff	US 6,231,442 B1	May 15, 2001
Bennett (Bennett '178)	US 6,261,178 B1	Jul. 17, 2001

Appellant seeks review of the Examiner's rejection under 35 U.S.C. § 102(b) of claims 1-3, 6-9, 12-14, 17-20, 23-25, 28-30, 33-35, 38-41, 43, and 45 as anticipated by Bennett '102 and rejections under 35 U.S.C. § 103(a) of claims 4, 15, 26, 36, and 44 as unpatentable over Bennett '102 in view of Mayeroff; claims 5, 16, 27, 37, and 42 as unpatentable over Bennett '102 in view of Bennett '178; and claims 10, 11, 21, 22, 31, and 32 as unpatentable over Bennett '102 in view of Walker.

We refer in this decision to the Examiner's Answer (mailed January 24, 2006) and Appellant's Appeal Brief (filed December 13, 2005) and Reply Brief (filed March 27, 2006).

## OPINION

### *The Anticipation Rejection*

The dispositive issue involved in this appeal is whether Bennett '102 discloses a controller programmed to receive data relating to a request by a user during occurrence of a wagering game to make an automated selection from among a plurality of user-selectable options presented to the user and to make an automated selection from among said plurality of user-selectable options in response to said request as called for in independent claims 1, 12, and 23, or steps of performing said receiving and selecting functions as recited in independent claim 33, or memory portions configured to cause the gaming apparatus to perform said receiving and selecting functions as recited in independent claim 41. In rejecting claims 1-3, 6-9, 12-14, 17-20, 23-25, 28-30, 33-35, 38-41, 43, and 45 as anticipated by Bennett '102, the Examiner finds that "a controller selecting a gaming option automatically from a plurality of user-selectable options if the user requests the controller to do so through not selecting an option" is taught by Bennett '102 (col. 4, ll. 30-33) (Answer 4). The portion of Bennett '102 alluded to by the Examiner teaches that the selection of a symbol position in a particular column would "default to the centre line position in the event that no symbol was selected" in said particular column (col. 4, ll. 30-33). Appellant argues that "[s]ince Bennett discloses defaulting to a center line position in the absence of a selection, it necessarily does not disclose receiving data relating to a request and making an automated selection from among user-selectable options," as

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called for in each of Appellant's independent claims 1, 12, 23, 33, and 41 (Appeal Br. 7).

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983). Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). Inherency may not be established by probabilities or possibilities; the mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981).

While we agree with the Examiner that the absence of a selection by the user may be considered a request to have the gaming apparatus make the selection (Answer 10-11), Bennett '102 does not disclose, either expressly or under principles of inherency, that the gaming apparatus receives data relating to the request by the user to have the gaming apparatus select the symbol position. Bennett '102 teaches that the touch sensitive membrane for making selections may be divided into a number of switch panels 52 each corresponding with one display position of the display 51 (col. 5, ll. 23-27), but does not specify how the gaming apparatus determines whether a selection has been made or how a default selection is triggered by the apparatus. There is nothing in the disclosure of Bennett '102 that would lead one of ordinary skill in the art to conclude that the gaming apparatus necessarily receives data indicating that a selection has not been made by the user, thus constituting a request for the gaming apparatus to make a default selection, and that the gaming apparatus makes the default selection in response to such request. A person of ordinary skill in the art would recognize that the gaming apparatus of Bennett '102 could operate, for example, by setting the switch for the center line position in each column to a normally closed (i.e., selected) position and toggling such center line position switch to the open (non-selected) position in response to the user selecting a different switch panel in that same column. Such operation would not require the gaming apparatus to receive data relating to a request (absence of a selection) by the user.

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In light of the above, Appellant has demonstrated the Examiner erred in determining that Bennett '102 discloses all the limitations of independent claims 1, 12, 23, 33, and 41, either expressly or under principles of inherency. The rejection of claims 1-3, 6-9, 12-14, 17-20, 23-25, 28-30, 33-35, 38-41, 43, and 45 as anticipated by Bennett '102 cannot be sustained.

*The Obviousness Rejections*

In rejecting the remaining dependent claims under 35 U.S.C. § 103(a), the Examiner does not rely on Mayeroff, Bennett '178, or Walker for any teaching that would remedy the deficiency of Bennett '102 discussed above. Accordingly, the rejections of claims 4, 15, 26, 36, and 44 as unpatentable over Bennett '102 in view of Mayeroff; claims 5, 16, 27, 37, and 42 as unpatentable over Bennett '102 in view of Bennett '178; and claims 10, 11, 21, 22, 31, and 32 as unpatentable over Bennett '102 in view of Walker likewise cannot be sustained.

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#### NEW GROUNDS OF REJECTION

We enter the following new grounds of rejection pursuant to 37 C.F.R. § 41.50(b):

Claims 1-3, 5-9, 12-14, 16-20, 23-25, 27-30, 33-35, 37-43, and 45 are rejected under 35 U.S.C. § 103(a) as unpatentable over Bennett '102 in view of Appellant's Admitted Prior Art (Specification 1:24 to 2:8) and Bennett '178.

Appellant does not contest the Examiner's findings that Bennett '102 discloses all of the limitations of claims 1-3, 6-9, 12-14, 17-20, 23-25, 28-30, 33-35, 38-41, 43, and 45, with the exception of the limitations directed to the gaming apparatus receiving data relating to a request from a person made during occurrence of the wagering game to make an automated selection from among a plurality of user-selectable options presented to the person and performing an automatic selection from among said plurality of user-selectable options in response to said request. Accordingly, we adopt these uncontested findings of the Examiner in our rejection.

As discussed above, Bennett '102 makes a default selection of the center line symbol position in the event that the user does not select a symbol position in a certain column, such non-selection being a request for the gaming apparatus to make the default selection from among the three symbol positions presented for that particular column for selection by the user. Bennett '102, however, does not disclose receiving data relating to a request for the gaming apparatus to make the selection. As admitted by Appellant (Specification 1:24 to 2:8), it was well known in the art at the time

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of Appellant's invention to include on the display of a video gaming apparatus a button that could be actuated by the player to allow the controller to randomly select from among a plurality of player-selectable options.

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

*KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007).

While the Admitted Prior Art specifically addresses Keno gaming devices, a person of ordinary skill in the gaming art at the time of Appellant's invention would have appreciated that including a button on the display of other gaming apparatus, such as the slot gaming apparatus of Bennett '102, to permit a player to input a request to have the controller of the gaming apparatus make the selection from among a plurality of user-selectable options would improve such slot gaming apparatus in much the same way, namely, by providing the player with a means to affirmatively request the gaming apparatus to make the selection. Moreover, Bennett '178 teaches that a player may cause a slot gaming apparatus of the type taught by Bennett '102 to randomly select more than one additional arrangement of

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locations in a game, with each such arrangement including one and only one symbol location in each column (Bennett '178, col. 2, ll. 23-27). Bennett '178 further evidences that the use of a controller to randomly select symbol positions for a pay line in a slot gaming apparatus of the type taught by Bennett '102 would have been within the technical grasp of a person of ordinary skill in the art (Bennett '178, col. 3, ll. 56-61). We thus conclude that it would have been obvious to modify Bennett '102 to provide a button on, or associated with, the display screen 51 to permit the player to input a request to have the controller of the gaming apparatus select a symbol position for the pay line on any particular column, or all columns, from the three positions presented to the player for selection. It would further have been obvious to have the controller of the gaming apparatus of Bennett '102 receive data, generated by pressing of the button by the player, relating to the request, and to make the selection of symbol position from among the three player-selectable positions in each column in response to the request, as a matter of ordinary creativity and common sense. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR*, 127 S.Ct. at 1742. The combined teachings of Bennett '102, Appellant's Admitted Prior Art, and Bennett '178 thus establish that the subject matter of claims 1-3, 6-9, 12-14, 17-20, 23-25, 28-30, 33-35, 38-41, 43, and 45 would have been obvious to a person of ordinary skill in the art at the time of Appellant's invention.

Claims 5, 16, 27, 37, and 42 depend from independent claims 1, 12, 23, 33, and 41, respectively, and include a further limitation that said selection is a random selection. The random selection by the controller of a gaming apparatus from among a plurality of user-selectable options was known in the art, as evidenced by Appellant's Admitted Prior Art and Bennett '178, as discussed above. To add the feature of random selection of symbol position in response to a player's request to do so, in order to add an element of mystery (Bennett '178, col. 3, l. 59), would have been obvious to a person of ordinary skill in the art at the time of Appellant's invention, as a matter of ordinary creativity.

Claims 4, 15, 26, 36, and 44 are rejected under 35 U.S.C. § 103(a) as unpatentable over Bennett '102 in view of Appellant's Admitted Prior Art and Bennett '178, and further in view of Mayeroff.

The Examiner finds that Mayeroff teaches the use of a multi-choice bonus game associated with a primary slot machine, wherein a plurality of user-selectable options are presented to the user (Answer 6). Appellant does not contest this finding. Nor does Appellant contest either (1) the Examiner's determination that it would have been obvious to a person of ordinary skill in the art to incorporate the bonus feature taught by Mayeroff in the multi-line slot game of Bennett '102 in order to increase player appeal of the machine through the incorporation of a secondary game as taught by Mayeroff (Answer 6) or (2) that such modification would yield the invention recited in claims 4, 15, 26, 36, and 44. Accordingly, we adopt the Examiner's findings and position in our rejection.

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Claims 10, 11, 21, 22, 31, and 32 are rejected under 35 U.S.C. § 103(a) as unpatentable over Bennett '102 in view of Appellant's Admitted Prior Art and Bennett '178, and further in view of Walker.

The Examiner finds that Walker teaches the inclusion of the internet for maintaining a network of slot machine servers (Answer 7). Appellant does not contest this finding. Nor does Appellant contest either (1) the Examiner's determination that it would have been obvious to a person of ordinary skill in the art at the time of Appellant's invention to incorporate the internet network of Walker in the slot machine of Bennett '102 to allow the device of Bennett '102 to communicate service requirements, to participate in para-mutual pool type games, or to allow remote monitoring of the machines or (2) that such modification would yield the invention recited in claims 10, 11, 21, 22, 31, and 32. Accordingly, we adopt the Examiner's findings and position in our rejection.

## CONCLUSION

The decision of the Examiner to reject claims 1-45 is reversed. New rejections of claims 1-45 under 35 U.S.C. § 103(a) are entered pursuant to 37 C.F.R. § 41.50(b).

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

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37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED; 37 C.F.R. § 41.50(b)

vsh

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